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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/396,128

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03/07/2007

EXAMINER

TRAN, HANH VAN

ART UNIT

PAPER NUMBER

3637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/396,128

Applicant(s)

THOMPSON, THOMAS

Examiner

Hanh V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/4/2006</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is the Final Office Action from the examiner in charge of this application in response to applicant's amendment dated 12/4/2006.

#### ***Drawings***

2. The drawings are objected to because the specification discloses in the Brief Description of the Drawings of figure 6A; however, figure 6A is not included in the drawing sheets. Please noted that applicant's proposed drawing correction of figure 6A filed on 2/20/2001 has not been approved by the examiner; thus objection to the drawing is still outstanding. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

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corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with terms which lack antecedent basis, such as: claim 22, "the top plate"; claim 23 "said extended tab". Claim 1, (i) lines 5-6, the limitation of the rectangular face having "one side of the dimension extended" is vague and indefinite for failing to clearly define the metes and bounds of the claimed invention; it is not clear what applicant is trying to define here; (ii) lines 7-9, the claim recited a right angled bend on "either end", not both ends, thus the recitation of "each forming a rafter tab" is indefinite, (iii) lines 12-15, it is not clear how it is possible for "a generally right angled bend on the side of the long dimension" is able to form "a plurality of sheathing tabs". Claims 22, 29, 32, 33, "the top plate" lacks antecedent basis. Claims 23, 24, 25, "the extended tab" lacks antecedent basis. Claims 25, 27, 28, "the rafter tabs" lacks antecedent basis. Claim 26, it is not clear how it is possible for the right angled bend of the sheathing tabs to be generally "parallel" to the long dimension, such that the sheathing tabs generally "perpendicular" to the rectangular face. Claim 27, it is not clear how it is possible for the right angled bends of the rafter tabs to be "parallel" to the short dimension, such that the rafter tabs

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"perpendicular" to the rectangular face. Claim 34, (i) lines 3-4, it is not clear how rectangular two "planes" forming left and right faces, (ii) line 22, "both plates" lacks antecedent basis. Claim 38, "coupled" plates lacks antecedent basis. Claim 39, it is not clear whether or not the rafters, the outside wall sheathing, the underlying top plate, the roof, wall of an existing building are being positively claimed in the claim. All claims will be examined as best understood or so far as definite.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 20-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,370,577 to Jonett et al.

Jonett et al discloses an apparatus for securing structural members of a building, Figs 2-3, comprising all the elements recited in the above listed claims and including a unitary body having a rectangular face with ventilation holes, a right angled bend forming a sheathing tab 26, rafter tabs 32', plate tabs 46', wall tabs 72, and a lower long side 72 extended down forming an extended tab, wherein each tab has a plurality of nail

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holes therein, the generally right angled bends of the sheathing tabs being generally parallel to the long dimension of the rectangular face, thereby placing the sheathing tabs generally perpendicular and adjacent to the rectangular face, the axis of said bends forming said rafter tabs being generally parallel to the short dimension of the rectangular face, and the axis of said bends forming said plate tabs being generally parallel to the rectangular face. The differences being that Jonett does not disclose a plurality of sheathing tabs, the sheathing tabs each having a bolt hole, the extended tab having a generally trapezoidal shape.

In regard to a plurality of sheathing tabs, instead of just one sheathing tab 26, it would have been obvious to one skill in the art to provide the structure of Jonett with a plurality of sheathing tabs instead of one integral sheathing tab, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Further, it also has been held that mere duplication of the essential working parts of a device involves routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In regard to the sheathing tabs each having a bolt hole, since Jonett also teaches the idea of providing holes to various parts of the apparatus for receiving fastening means therein, it would have been obvious to provide each sheathing tab with a hole in order to receive a fastening means therein. In regard to the extended tab having a generally trapezoidal shape, it would have been an obvious matter of design choice to modify the structure of Jonett by providing the extended tab with a trapezoidal shape, since applicant has not provide the

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criticality of having the extended shape with this specific shape, and it appears that the extended tab of Jonett would perform equally as well.

8. Claims 34-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jonett et al.

Jonett et al discloses an apparatus for securing structural members of a building, Figs 2-3, comprising all the elements recited in the above listed claims and including a unitary body having a rectangular face with ventilation holes, a right angled bend forming a sheathing tab 26, rafter tabs 32', plate tabs 46', wall tabs 72, and a lower long side 72 extended down forming an extended tab, wherein each tab has a plurality of nail holes therein, the generally right angled bends of the sheathing tabs being generally parallel to the long dimension of the rectangular face, thereby placing the sheathing tabs generally perpendicular and adjacent to the rectangular face, the axis of said bends forming said rafter tabs being generally parallel to the short dimension of the rectangular face, and the axis of said bends forming said plate tabs being generally parallel to the rectangular face. The only different being that Jonett does not disclose the apparatus being formed of two flat plates, with one of the plates having horizontal tracks with openings on one end and the other plate having runners with faces and arms.

It would have been obvious and well within the level of one skill in the art to modify the apparatus of Jonett et al by having the apparatus being formed of two flat plates, with one of the plates having horizontal tracks with openings on one end and the

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other plate having runners with faces and arms for the purpose of making the apparatus adjustable to different sizes.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the apparatus of Jonett et al being formed of two flat plates, with one of the plates having horizontal tracks with openings on one end and the other plate having runners with faces and arms for the purpose of making the apparatus adjustable to different sizes, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

### ***Response to Arguments***

9. Applicant's arguments filed 12/4/2006 have been fully considered but they are not persuasive. In response to applicant's argument on pages 4-5 that applicant's claimed invention only has one rectangular face, while Jonett shows two, the examiner takes the position that the transitional term "comprising" is an inclusive or open-ended and does not exclude additional, unrecited elements.

10. In response to applicant's argument on page 5 that applicant only claimed "a singular extended tab on one edge of the long dimension", while Jonett clearly shows two tabs 72, the examiner again takes the position that the transitional term "comprising" is an inclusive or open-ended and does not exclude additional, unrecited elements. Further, it is noted that the features upon which applicant relies (i.e., a singular extended tab on one edge of the long dimension) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from



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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. In response to applicant's argument on page 5 that Jonett fails to show the sheathing tabs are "adjacent" to the rectangular face, the examiner takes the position that the term "adjacent" is broad enough that Jonett still meets the claimed limitation.

12. In response to applicant's argument on page 6, # 17, the examiner takes the position that the claimed language fails to provide adequate structural limitations in order to distinguish from the prior art of record.

13. In response to applicant's argument on page 7 that applicant's amended claim 39 stated wind and earthquake resistance and thus read over Jonett, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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14. In response to applicant's argument on page 7, #19 that since Jonett's apparatus can be bent to fit, there is not need for an adjustable two-piece frieze board, the examiner takes the position that the mere fact of being bendable does not preclude an apparatus to have adjustability, since the benefit of providing an adjustable two-piece frieze board is to allow for installation of the apparatus with various distances between top chords 12.

### ***Conclusion***

15. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$250.00.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

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A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HVT *HVT*  
March 4, 2007

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